No. 00-1543

IN THE

Supreme Court of the United States

FESTO CORPORATION,

Petitioner,

v.

SHOKETSU KINZOKU KOGYO KABUSHIKI CO., LTD., a/k/a SMC CORPORATION AND SMC PNEUMATICS, INC.,

Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF OF INTERNATIONAL BUSINESS MACHINES CORPORATION, EASTMAN KODAK COMPANY, FORD MOTOR COMPANY, E.I. DU PONT DE NEMOURS AND COMPANY, AGERE SYSTEMS INCORPORATED AND THE FINANCIAL SERVICES ROUNDTABLE AS *AMICI CURIAE* IN SUPPORT OF RESPONDENTS

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BRIEF OF INTERNATIONAL BUSINESS MACHINES CORPORATION, EASTMAN KODAK COMPANY, FORD MOTOR COMPANY, E.I. DU PONT DE NEMOURS AND COMPANY, AGERE SYSTEMS INCORPORATED AND THE FINANCIAL SERVICES ROUNDTABLE[1]

INTEREST OF *AMICI CURIAE*

Amici curiae International Business Machines Corporation, Eastman Kodak Company, Ford Motor Company, E.I. du Pont de Nemours and Company and Agere Systems Incorporated oversee large research and development ("R&D") organizations. These Amici employ thousands in R&D activities, including Nobel laureates, National Medal of Science honorees and National Medal of Technology recipients, at a collective investment of approximately 10 billion dollars a year.

As a result of their commitment to technological research and development, these Amici have received tens of thousands of United States patents including many patents universally recognized as pioneering. IBM alone has received more United States patents than any other assignee in each of the last 8 years. These Amici also manufacture, distribute and sell products resulting from their investment in research and development. As manufacturers, distributors and sellers of products, these Amici are often involved in granting licenses to others under their own patents, evaluating the patents of others, obtaining licenses under patents of others and litigating their own patents as well as patents asserted by others. In each of these endeavors, the potential applicability of the doctrine of equivalents — particularly under the Federal Circuit's previous "flexible" approach to prosecution history estoppel — had been an

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1. In accordance with Supreme Court Rule 37.6, Amici state that this brief was authored in its entirety by the counsel listed herein. No person or entity other than Amici listed on the cover made a monetary contribution to the preparation or submission of this brief. Letters reflecting written consent of the parties to the submission of this brief have been filed with the Clerk of the Court.

important consideration. As a result, these Amici have had substantial practical experience in dealing with the interplay between the doctrine of equivalents and prosecution history estoppel.

The Financial Services Roundtable is a non-profit industry association which seeks consensus among integrated financial services companies on issues of public and financial policy that shape the competitive marketplace and national economy. Membership in The Financial Services Rountable is limited to the 100 major integrated financial services companies in the United States. The members of The Financial Services Roundtable own patents and have analyzed and licensed patents, particularly patents relating to "business methods" and financial services.[2]

As leading recipients, licensees, licensors and litigants of patents, Amici are committed to maintaining the integrity of United States patent law and to its proper interpretation and application. By virtue of their broad practical experience both from the perspective of a patentee and from the perspective of the public trying to gauge the scope of a patent, Amici believe their views can aid this Court in the resolution of the issues raised in this appeal. Amici submit this brief in support of Respondents and urge this Court to affirm the decision of the Federal Circuit.

INTRODUCTION AND SUMMARY OF ARGUMENT

Just four years ago, this Court recognized the danger of an unchecked doctrine of equivalents noting that "the doctrine of equivalents, as it has come to be applied since *Graver Tank [& Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605 (1950)], has taken on a life of its own, unbounded by the patent claims" and "when applied broadly, conflicts with the definitional and public-notice functions of the statutory claiming requirement." *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 28-29 (1997).

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2. For ease of reference, "Amici" is used hereinafter to refer to IBM, Kodak, Ford, DuPont, Agere and The Financial Services Roundtable as representative of its members.

To address those concerns, the *Warner-Jenkinson* Court reaffirmed its precedent that a limiting claim element added by amendment to avoid prior art created prosecution history estoppel barring application of the doctrine of equivalents as to that element. Earlier cases of this Court had consistently applied prosecution history estoppel to "strictly" limit any claim element narrowed by an amendment to avoid prior art — in other words as a complete bar to the doctrine of equivalents for that element. The *Warner-Jenkinson* Court extended the reach of prosecution history estoppel to unexplained claim amendments (*i.e.* amendments not accompanied by remarks stating reasons for the amendments). Specifically, where there is no explanation for a claim amendment, "[a] court should presume that the patent applicant had a substantial reason related to patentability for including the limiting element added by amendment. In those circumstances, prosecution history estoppel would *bar* the application of the doctrine of equivalents as to that element." 520 U.S. at 33 (emphasis added).

Consistent with *Warner-Jenkinson* and this Court's prior cases, the Federal Circuit in this case held that a narrowing amendment to a claim element for "any reason related to the statutory requirements for a patent" will create prosecution history estoppel. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 566 (Fed. Cir. 2000) (*en banc*), *cert. granted*, 121 S. Ct. 2519 (2001). The Federal Circuit thus interpreted the expression "a substantial reason related to patentability" in *Warner-Jenkinson*, 520 U.S. at 33 to mean "any reason related to the statutory requirements for a patent." *Festo*, 234 F.3d at 566. Thus, under *Festo*, the doctrine of equivalents remains fully applicable to: (i) all unamended claims, (ii) all unamended elements in a claim, (iii) all amended claim elements that were not narrowed, and (iv) all amended claim elements that were narrowed but not for statutory patentability reasons.

The Federal Circuit also resolved a conflict in its own precedent by rejecting its "flexible" approach to prosecution

history estoppel and held that: "When a claim amendment creates prosecution history estoppel . . . there is no range of equivalents available for the amended claim element. Application of the doctrine of equivalents to the claim element is completely barred (a 'complete bar')." *Festo*, 234 F.3d at 569. The Federal Circuit's reasoning expressly drew on the special expertise it has developed from nearly 20 years of experience in this area:

> Our decision to reject the flexible bar approach adopted in Hughes I comes after nearly twenty years of experience in performing our role as the sole court of appeals for patent matters. In those years, the notice function of patent claims has become paramount, and the need for certainty as to the scope of patent protection has been emphasized. A problem with the flexible bar approach is that it is virtually impossible to predict before the decision on appeal where the line of surrender is drawn.
>
> * * *
>
> After our long experience with the flexible bar approach, we conclude that its "workability" is flawed.

Festo, 234 F.3d at 574-75.

As research and development organizations that own and license significant patent portfolios and as manufacturers, distributors and sellers/providers of products and services that evaluate the patents of others, Amici agree with the Federal Circuit that the workability of the "flexible" approach to prosecution history estoppel is flawed. *See* Brief For The United States As Amicus Curiae at 27, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.* (No. 00-1543) (Federal Circuit "properly concluded" flexible approach is "unworkable"). The "flexible" approach and the unpredictable results arising from its variable application to claim amendments created substantial uncertainty surrounding the scope of patent claims. *Festo*, 234 F.3d at 577

(under the flexible approach, the "exact range of equivalents when prosecution history estoppel applies is virtually unascertainable").

The zone of uncertainty that resulted from application of the "flexible approach" led to substantial difficulty in planning product launches and other commercial activities, and, in some cases had a chilling effect on the commercialization of technological innovation. For example, bringing a new product or service to market requires massive investment in research, development, manufacturing, distribution and sales. Before making such an investment, companies like Amici encounter situations where they evaluate the patents of others in order to assess the potential risk of an injunction or a damages judgment that could result from patent litigation. Under the "flexible" approach to prosecution history estoppel, Amici and other companies similarly situated could not confidently proceed without risking an adverse judgment based on application of the doctrine of equivalents, even when the patentee narrowed a claim element by amendment to avoid prior art.

Moreover, for many Amici, after they decided to launch a new product or service, the success of that new offering all too often was followed by overbroad allegations of patent infringement. Such allegations were maintained even when literal infringement was unquestionably absent and the claim element required to cover the new product by equivalents was substantively narrowed by amendment. *See Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1537 (Fed. Cir. 1995) (Plager, J., dissenting) (doctrine of equivalents is being abused by patentees "seek[ing] greater coverage for their patents than the patent statute grants."), *rev'd*, 520 U.S. 17 (1997). Nevertheless, pressured by the uncertainties created by the flexible approach to prosecution history estoppel, companies like Amici often settled. Unfortunately, these costs were ultimately passed on to the public.

Finally, Amici believe none of the doomsday predictions made by Petitioner's proponents will actually materialize.

For example, no realistic expectation of any prudent patentee will be dashed by strict adherence to prosecution history estoppel, nor will Patent Office practice be adversely affected. To the contrary, Patent Office practice will be improved by submission of better prepared and prosecuted patent applications and the scope of issued patents will be more predictable for patentees and the public alike.

In *Festo*, the Federal Circuit has struck a fair balance between rewarding the inventor's patentable contribution and allowing the public to rely on explicit disclaimers in the form of narrowing amendments made to obtain a patent. Consistent with this Court's directive in *Warner-Jenkinson*, the Federal Circuit's rulings will foster greater "certainty, consistency, and reviewability," 520 U.S. at 39 n. 8, and hence fairness, in administering the patent laws, while still preserving a viable doctrine of equivalents reflecting the realities of the patent application process.

I. THE EXPERIENCE OF AMICI CONFIRM THAT THE COURT OF APPEALS' DECISION CORRECTLY BALANCES THE INTERESTS OF PATENTEES AND THE PUBLIC

Collectively, Amici have first-hand experience with the doctrine of equivalents and prosecution history estoppel from a variety of different perspectives — *i.e.*, that of patentees asserting and licensing patents; that of manufacturers, distributors and sellers/providers of products and services evaluating patents of others; and that of patentee-plaintiffs or accused infringers in litigation. By virtue of that experience, Amici appreciate the need for an appropriate balance between the continuing viability of the doctrine of equivalents to protect inventors' rights and the public interest in promoting the definitional and public notice functions of patent claims.

Amici have extensive and wide-ranging patent portfolios. Amici license their patents to others to generate revenue and to obtain access to patents of others by way of cross-licenses. For example, IBM has one of the largest, if not the largest,

portfolios of active United States patents and generates substantial revenues each year from licensing of its United States patents to hundreds of licensees. Amici also protect their substantial investments in research and development by excluding others from practicing their patents except where royalties are paid or other consideration given to help offset their innovation expenses. DuPont and Kodak in particular frequently assert their patents to protect markets for important products. Amici therefore favor a strong United States patent system and broad patent protection.

However, as manufacturers, distributors and sellers/providers of products and services, Amici are often involved in evaluating the patents of others both before and after launch of new products. In Amici's experience the "flexible" approach to prosecution history estoppel has caused great uncertainty because of the unpredictable results arising from its variable application to claim amendments. This unpredictability occurred even where a claim element was substantively narrowed by amendment to avoid prior art and that element was not present in the new product (*i.e.* no literal infringement).[3] As a result, Amici could not confidently proceed to market. Rather, Amici have been forced to operate under a cloud of uncertainty as to the risk of ultimately being found to have infringed. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390 (1996) ("'[t]he limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject matter of the patent will be dedicated ultimately to the public.' Otherwise, a 'zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage

3. *See, e.g., Tandon Corp. v. United States Int'l Trade Comm'n*, 831 F.2d 1017, 1026-28 (Fed. Cir. 1987) (prosecution history estoppel did not preclude equivalents despite amendment of claim to avoid prior art); *LaBounty Mfg., Inc. v. United States Int'l Trade Comm'n*, 867 F.2d 1572, 1575-76 (Fed. Cir. 1989) (claim was amended to avoid prior art but court required analysis of prior art to determine extent of subject matter surrendered before invoking prosecution history estoppel).

invention only a little less than unequivocal foreclosure of the field.'. . .") (citations omitted).

Amici believe that the Court of Appeals' decision in *Festo* is correct, as it preserves an appropriate balance between the protection of patentable innovation while providing certainty for the public in planning a course of commercial activity. *See White v. Dunbar*, 119 U.S. 47, 52 (1886) ("The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms."); *Warner-Jenkinson*, 520 U.S. at 33 (noting need for "proper deference to the role of claims in defining an invention and providing public notice"). Most companies — such as Amici — conduct their own independent and costly research and development to bring innovative new products and services to market and to gain advantage over their competition. Despite these substantial investments, Amici have been subjected to allegations of patent infringement based on overly broad views of equivalents made possible by the "flexible" approach to prosecution history estoppel.

Amici also believe that the very unpredictability of the flexible approach tended to encourage litigation and produce unfair jury verdicts (and oftentimes excessive damages awards). The abuses observed by the Federal Circuit resulting from unbridled availability of the doctrine of equivalents were highlighted by Judge Lourie:

> It has been said that there is no hard evidence showing that the so-called "flexible" bar impairs predictability. While it is true that empirical data may not be available, powerful evidence may be garnered from the experience of this court, which monthly reviews appeals in which infringement is asserted under the doctrine of equivalents even though the accused product is clearly not within the literal scope of the asserted claims. Many of these

> appeals involve prosecution histories in which amendments for patentability reasons have been made. Yet, equivalence is argued in the hope that one panel might find equivalence where another would not. That surely is persuasive evidence that the current flexible bar is not working.

Festo, 234 F.3d at 596 (Lourie, J., concurring). Similarly, Judge Plager has stated:

> [t]he doctrine of equivalents is a virtually uncontrolled and unreviewable license to juries to find infringement if they so choose. And this is done largely without regard to and independent of the express limitations of the patent claims which may have brought about their allowance by the Patent and Trademark Office (PTO) in the first place.

Hilton-Davis, 62 F.3d at 1538 (Plager, J., dissenting) (citation omitted). *See Festo*, 234 F.3d at 576 (flexible approach is "a benefit [to the patentee] that comes at the public's expense.").

Prosecution history estoppel is a question of law. However, in practice, the "flexible" approach to prosecution history estoppel was typically considered to have raised issues of fact concerning what an applicant actually surrendered during prosecution in relation to the product accused of infringement. Consequently, district courts had been reluctant to grant summary judgment of noninfringement, and patent infringement cases would persist, simply because of the theoretically possible need to resolve these fact issues. Thus, confident that their cases could withstand summary judgment, patentees with questionable or unmeritorious cases felt little or no constraint in pursuing litigation. Those patentees knew full well that the mere pendency of a suit, with its attendent threat of a large damages award or an injunction against an important product or service, could induce a company to pay a large settlement. Even companies that fought and won often found their victories Pyrrhic, because of the expense of patent litigation. The Federal Circuit has now restored prosecution history estoppel as an effective legal limit

on the doctrine of equivalents which district courts will use more confidently to summarily decide cases where the prosecution history demonstrates that resort to the doctrine of equivalents should be barred. *See Warner-Jenkinson*, 520 U.S. at 39 n. 8.

Contrary to the position of Petitioner and its proponents, the Federal Circuit ruling is not unfair to patent applicants. Patent applicants have many options during prosecution before the Patent Office — they can: (i) amend their claims; (ii) argue for patentability without amending claims; or (iii) appeal through the Patent Office and to the Federal Circuit if they believe the patent examiner is incorrect. *See Smith v. Magic City Kennel Club*, 282 U.S. 784, 789-90 (1931) ("If dissatisfied with the rejection [the patentee] should pursue his remedy by appeal; and where, in order to get his patent, he accepts one with a narrower claim, he is bound by it.") (citations omitted); *Festo*, 234 F.3d at 597 (Lourie, J., concurring) (a patent applicant "is master of his claims. He can stand his ground and appeal, or amend the claims. If the latter course of action is chosen, such conduct, which is known to the world, should bind the applicant."). Patent practitioners are well aware of these various options and when each ought to be used.[4] When a patentee opts to amend a claim in order to obtain a patent, the patentee has struck a bargain with the Patent Office and thereby accepted the amended claims as a fair reward for the disclosed invention in light of the prior art and other statutory requirements of patentability. The patentee should be held to its bargain and the public should be entitled to rely on it.

By restoring application of prosecution history estoppel as a complete legal bar to the doctrine of equivalents in accordance with long-standing Supreme Court authorities, *see* Section II, *infra*, the Federal Circuit has brought the doctrine of equivalents

4. To practice before the Patent Office, an attorney, regardless of state or federal court bar admissions, is required to take and pass the Patent Office agency examination. 37 C.F.R. § 10.7(b). The Patent Office is the only federal government agency that has its own licensing examination.

and prosecution history estoppel back into appropriate balance. The inventor's patentable contribution is still rewarded — as measured by the claims and agreement reached during prosecution — because the doctrine of equivalents remains fully available to all claim elements not narrowed for statutory patentability purposes and, of course, literal infringement is always available. The public, on the other hand, gains because it can objectively determine the reach of a patent with much greater certainty and plan its commercial activities with far greater confidence, all based on the public record created before the Patent Office. The greater "certainty, consistency and reviewability" fostered by the Federal Circuit's decision will strengthen the United States patent system.

II. WITH RESPECT TO QUESTION 2, THE COURT OF APPEALS' DECISION IS CORRECT THAT WHERE PROSECUTION HISTORY ESTOPPEL APPLIES IT COMPLETELY BARS ANY RANGE OF EQUIVALENTS

The Federal Circuit's ruling that prosecution history estoppel, when it applies, completely bars any range of equivalents for the amended claim element is fully supported by *Warner-Jenkinson* and this Court's other modern precedent. Collectively, these precedent have characterized the effect of prosecution history estoppel as a "bar", a "disclaimer" and an "abandonment", which should be "strictly construed" against the patentee.

The leading modern Supreme Court case on prosecution history estoppel, *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126 (1942), held that by making a narrowing amendment to a claim element to avoid prior art, the patentee had affirmatively abandoned any subject matter between the claim element as originally claimed and as amended, precluding any range of equivalents for that claim element: "By the amendment [the patentee] *recognized and emphasized the difference* between the two phrases *and proclaimed his abandonment of all that is embraced in that difference*." *Id.* at 136 (citations omitted,

emphasis added). The *Exhibit Supply* Court emphasized the gravity of such a disclaimer:

> *The difference* which he thus disclaimed *must be regarded as material*, and *since the amendment operates as a disclaimer of that difference it must be strictly construed against him* . . . It follows that *what the patentee*, by a strict construction of the claim, *has disclaimed* — conductors which are carried by the table but not embedded in it — *cannot now be regained by recourse to the doctrine of equivalents*, which at most operates, by liberal construction, to secure to the inventor the full benefits, not disclaimed, of the claims allowed.

Id. at 137 (citations omitted, emphasis added). *See* Brief For The United States As Amicus Curiae at 24, *Festo* (No. 00-1543) (citing *Exhibit Supply* for the proposition that "when a patent applicant submits a narrowing amendment to avoid prior art, the applicant by necessary implication disclaims the range of equivalents that falls between the original and the amended claims").

Similarly, in the earlier case of *Smith v. Magic City Kennel Club, Inc.*, 282 U.S. 784 (1931), this Court determined that since the patentee narrowed a claim element to avoid prior art, the patentee had made a disclaimer which must be "strictly construed" against it:

> The applicant having *limited his claim by amendment* and accepted a patent, brings himself within the rule[s] that . . . limitations imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, *must be strictly construed against the inventor and looked upon as disclaimers.*

Id. at 790 (citations omitted, emphasis added).

More recently, in the circumstance where there was no explanation for an amendment, the *Warner-Jenkinson* Court

characterized the effect of prosecution history estoppel as a presumptive bar on the doctrine of equivalents:

> Where no explanation is established, however, the court should presume that the patent applicant had a substantial reason related to patentability for including the *limiting element added by amendment*. In those circumstances, prosecution history estoppel would *bar the application of the doctrine of equivalents* as to that element.

520 U.S. at 33 (emphasis added). *See* Petition For Writ Of Certiorari Of The United States at 14-15, *United States v. Hughes Aircraft Co.* (No. 98-871) (*Warner-Jenkinson* "unambiguously states that, if a patent applicant adds a limiting element to a patent claim for 'a substantial reason related to patentability,' then 'prosecution history estoppel would *bar* the application of the doctrine of equivalents as to that element'"; the flexible approach "conflicts with the 'blunt and clear' words of *Warner-Jenkinson*."). Amici understand this Court's use of the word "bar" was no mistake, as Petitioners and their supporters argue by implication. Rather, it stands as a confirmation of its long-standing precedent that prosecution history estoppel completely "defeats, annuls, cuts off, or puts an end to" the doctrine of equivalents as to an amended claim element. *Black's Law Dictionary* 148 (6th ed. 1990).

Exhibit Supply and *Magic City Kennel Club* are part of a long line of 20th Century Supreme Court cases strictly applying prosecution history estoppel to bar any range of equivalents for claim elements that were narrowed by amendment to avoid prior art.[5] *Warner-Jenkinson* applied the logic of these earlier

5. *See, e.g., I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 443-44 (1926) (claim amendments "must be strictly construed against the inventor and looked upon as disclaimers"); *Keystone Driller Co. v. Northwest Eng'g. Corp.*, 294 U.S. 42, 48-49 (1935) ("we do apply the principle that, where such broad claims are denied and a narrower substituted, the patentee is estopped to read the granted claim as the (Cont'd)

decisions to unexplained amendments, reiterating the effect of prosecution history estoppel as a "bar". Notwithstanding the dicta from 19th Century cases cited by Petitioner and its proponents,[6] this Court's modern cases have consistently applied this principle. The Federal Circuit in *Festo* correctly aligned itself with this Court's precedent.

Accordingly, the Federal Circuit was correct in holding that prosecution history estoppel, once found with respect to an amended claim element, completely bars application of the doctrine of equivalents to that claim element.

III. WITH RESPECT TO QUESTION 1, THE COURT OF APPEALS' DECISION IS CORRECT THAT PROSECUTION HISTORY ESTOPPEL IS CREATED BY ALL NARROWING AMENDMENTS RELATED TO ANY STATUTORY REQUIREMENT FOR PATENTABILITY

There can be no dispute that where a narrowing amendment is made to a claim element in order to avoid prior art, prosecution history estoppel is created. As to whether the estoppel arises for narrowing amendments related to all statutory requirements for patentability — not just those made to avoid prior art — Amici

(Cont'd)
equivalent of those which were rejected. . . . In other words, we find no justification for enlarging the scope of what is described, but rather the requirement of strict limitation to that which is specified. . . ."); *Weber Elec. Co. v. E.H. Freeman Elec. Co.*, 256 U.S. 668, 677-78 (1921) ("Having thus narrowed his claim against rotary movement in order to obtain a patent the patentee may not by construction, or by resort to the doctrine of equivalents, give to the claims the larger scope which it might have had without the amendments, which amount to a disclaimer of rotation as an operative feature of his device.").

6. None of the cases cited by Petitioner actually holds infringement under the doctrine of equivalents. *Festo*, 234 F.3d at 571. One of the cases cited by Petitioner, *Odiorne v. Winkley*, 18 F. Cas. 581 (C.C.D. Mass 1814), is inapposite because it was decided over 20 years *before* patent claims were statutorily required. Act of July 4, 1836, ch. 357, § 6, 5 stat. 117; *see* D. Chisum, *Chisum On Patents* § 8.02 (2000).

believe the Federal Circuit was correct. The statutory requirements of patentability provide the most objective and logical standard for determining whether an amendment was made for "a substantial reason related to patentability." *Warner-Jenkinson*, 520 U.S. at 33.

The Federal Circuit concluded that an amendment made to overcome a non-prior art rejection will create prosecution history estoppel if it "narrows the scope of [the] claim for any reason related to a statutory requirement for a patent." *Festo*, 234 F.3d at 566. That conclusion follows directly from *Warner-Jenkinson* which ruled that an unexplained "limiting element added by amendment" is presumed to have been made for patentability purposes and, unless rebutted, will invoke prosecution history estoppel. 520 U.S. at 33. Since an unexplained amendment presumptively creates prosecution history estoppel, that estoppel must also logically be created by a claim element narrowed by amendment where the prosecution history makes clear that the amendment was made for a "substantial reason for patentability" — whether or not related to prior art. *Litton Systems, Inc. v. Honeywell Inc.*, 145 F.3d 1472, 1475-76 (Fed. Cir. 1998) (Garjarsa, J., dissenting from denial of rehearing *en banc*) ("It defies logic to read *Warner-Jenkinson* to hold that an amendment that is known to have been made for patentability reasons is to be treated differently than an amendment that is presumed to have been made for patentability reasons."). *See* Brief For The United States As Amicus Curiae at 15, *Festo* (No. 00-1543) (Federal Circuit holding has "compelling force" because "it should not matter whether the impetus was a prior art rejection or some other patent law requirement.").[7] Thus, for example, narrowing claim amendments made in response to a rejection under Section 112 paragraph 1[8] (claim not adequately described

7. Petitioner's assertion that the title of chapter 10 of the Patent Code is determinative of what qualifies as a "patentability" reason truly elevates form (a section title in the Patent Code) over substance (all of the substantive statutory requirements for the grant of a patent).

8. 35 U.S.C. § 112 ¶1.

or enabled by the patent specification) should create prosecution history estoppel. *See Crawford v. Heysinger*, 123 U.S. 589, 602-07 (1887) (prosecution history estoppel applied to amendment made in response to a rejection for inoperability).

However, consistent with *Warner-Jenkinson*, not all amendments create prosecution history estoppel. Claim amendments made in response to an indefiniteness rejection under Section 112 paragraph 2[9] either to correct grammatical errors or provide proper antecedent basis would not ordinarily be considered narrowing and thus not create prosecution history estoppel. *See Hubbell v. United States*, 179 U.S. 77, 80 (1900) ("where the differences between the claim as made and as allowed consist of mere changes of expression, having substantially the same meaning, such changes, made to meet the views of the examiners, ought not to be permitted to defeat a meritorious claimant.").

Consistent with *Hubbell* and this Court's other precedent, the Federal Circuit's holding leaves entirely intact the doctrine of equivalents with respect to all claim elements that were not narrowed by amendment to satisfy a statutory requirement for patentability. *Festo*, 234 F.3d at 567-68 ("if a patent holder can show from the prosecution history that a claim amendment was not motivated by patentability concerns, the amendment will not give rise to prosecution history estoppel"); Brief For The United States As Amicus Curiae at 15-16, *Festo* (No. 00-1543); *see, e.g., Turbocare v. General Electric Co.*, No. 00-1349, 2001 WL 988030 (Fed. Cir. Aug. 29, 2001) (doctrine of equivalents not barred because amendment of claim not narrowing). Thus, the doctrine of equivalents remains fully applicable to: (i) all claims that have not been amended, (ii) all unamended elements in a claim, (iii) all amended claim elements that were not narrowed (*e.g.* an amendment that broadens a claim by deleting a term or element), and (iv) all amended claim elements that were narrowed but not for statutory patentability reasons.

9. 35 U.S.C. § 112 ¶2.

Amici believe that it is both logical and balanced to impose prosecution history estoppel on narrowing amendments: (i) made to avoid the prior art as in *Exhibit Supply* and *Magic City Kennel Club*; (ii) made without explanation as in *Warner-Jenkinson*; and (iii) acknowledged to have been made to satisfy any statutory prerequisite for a patent — prior art or otherwise. The definitional and notice functions of patent claims are implicated whenever claims are amended to satisfy any statutory requirement for a patent, not just when the reason relates to prior art. The patent applicant is the "master of his claims" and should, on balance, bear the consequences of amending those claims.

IV. PETITIONER AND ITS PROPONENTS INCORRECTLY CHARACTERIZE THE IMPACT OF THE COURT OF APPEALS' DECISION

A. No "Settled Expectations" Of Patentees Or The Patent Office Have Been Upset

Petitioner and its proponents have argued that the Federal Circuit upset "settled expectations" of the owners of 1.2 million extant patents.[10] Amici disagree. There never were or should have been any settled expectations of equivalents with respect to claim elements narrowed by amendment for patentability reasons during prosecution. First, the precedent of this Court consistently applied the complete bar to any limiting element added to avoid prior art. *See* Section II, *supra*. Second, since the Federal Circuit had developed two lines of authority over the last 20 years — the "flexible" approach to prosecution history estoppel and the complete bar — its own authority was inconsistent. Such inconsistency could not have led to any reasonable expectation at all with regard to the doctrine of equivalents. Not only was the Federal Circuit unpredictable in applying prosecution history estoppel, but its "flexible" approach

10. 1.2 million is a gross exaggeration of the number of patents actually affected by the Federal Circuit decision. First, a substantial number of patent claims, and even more individual elements of patent claims, pass through the Patent Office without being amended. Second, only a fraction of the 1.2 million patents are ever asserted.

was misaligned with the long-standing precedent of this Court. Moreover, throughout the past two decades, well-respected commentators have warned patent practitioners to exercise due care in patent prosecution because a claim amendment may bar resort to the doctrine of equivalents.[11]

Thus, there could not reasonably have been any "settled expectations" that were upset by *Festo*. *See* Brief For The United States As Amicus Curiae at 24, *Festo* (No. 00-1543) ("patent holders have been on notice that they cannot assume, without considerable risk, that a narrowing amendment, made to overcome a patentability rejection, will embrace more than its literal terms.").[12] In fact, Judge Lourie, reflecting the Federal Circuit's many years of experience in this area, convincingly addressed any notion that patentees had settled expectations in the "flexible" approach to prosecution history estoppel:

> It has been suggested that there are settled expectations in the bar and innovation community regarding the present rule. The only settled expectation currently existing is the expectation that

11. *See, e.g.*, R. Harmon, *Patents And The Federal Circuit* § 6.3(b) (3d ed. 1994) (prosecution history estoppel "bars a patentee from construing its claims in a way that would resurrect subject matter previously surrendered during prosecution of the patent application. It limits a patentee's reliance upon the doctrine of equivalents by preventing it from contending later that its claims should be interpreted as if limitations added by amendment were not present or that claims abandoned are still present.").

12. Petitioner's argument that these 1.2 million patents "were freely amended to satisfy the examiners" with no intended consequences is unrealistic and unfair to the public. *See* n. 4, *supra*, and accompanying text. If applicants really did amend their claims "freely" in order to get a patent granted, with an expectation that whatever changes they made could be recaptured by the doctrine of equivalents, then it is both the statutory requirement for precise claiming and the principle of prosecution history estoppel that have each been reduced to a "hollow thing", with the doctrine of equivalents providing an unfettered failsafe mechanism by which patentees can avoid accountability for limiting amendments.

> clever attorneys can argue infringement outside the scope of the claims all the way through this court of appeals. Such a settled expectation should become unsettled. Surely, when prosecuting a patent, patent practitioners have no settled expectations of being able to assert the doctrine of equivalents. Any patent attorney who fails to claim all that his inventor has invented, and that is patentable, is ill-advised to settle for a narrower claim than he considers justified on the assumption that he can rely on the doctrine of equivalents for broader coverage. Such reliance is a highly risky prospect given that the patent statute requires precise claims.

Festo, 234 F.3d at 596-97 (Lourie, J., concurring) (citation omitted).[13]

Petitioner and its proponents have suggested that the Patent Office examines and grants patent applications with an expectation of equivalents. Once again, Judge Lourie rejected that argument:

> [T]he PTO does not make "basic assumptions" relating to a range of equivalents to be allowed. The PTO examines claims in light of the disclosure of the patent application and against the prior art. *See* 35 U.S.C. § 131 (1994) ("Examination of application"); Manual of Patent Examining Procedure §§ 701, 702 (7th ed. 2000) ("The main conditions precedent to the grant of a patent to an applicant are set forth in 35 U.S.C. [§§] 101, 102

13. Petitioner and its proponents also argue that the Federal Circuit's decision is tantamount to a Fifth Amendment taking and should not be applied to extant patents. Because there were no reasonable settled expectations in the flexible approach to prosecution history estoppel, that argument is incorrect. Moreover, Amici submit that Petitioner's arguments would apply equally to the presumption of prosecution history estoppel applicable to unexplained amendments established by this Court in *Warner-Jenkinson*. The Court did not create an exception for extant patents in that case and there is no reason to do so here.

> and 103 .... [T]he examiner should review the contents of [a new] application to determine if the application meets the requirements of 35 U.S.C. [§] 111(a) [(setting forth the basic requirements for a patent application)].''). It does not issue patents with any expectations regarding equivalents.

Festo, 234 F.3d at 597 (Lourie, J., concurring) (citation omitted).

That the Patent Office does not, indeed is not empowered to, consider the doctrine of equivalents flows from the fact that the doctrine of equivalents is a judicial instrument of patent enforcement rather than patent examination. Enforcement of patents is the exclusive jurisdiction of the district courts; the Patent Office only examines and issues patents. *Compare* 28 U.S.C. § 1338 (exclusive jurisdiction of district courts in patent infringement cases) *with* 35 U.S.C. § 2 (authority of Patent Office to grant patents).

B. Following *Festo*, District Courts And The Federal Circuit Have Been Careful To Preserve The Doctrine Of Equivalents

Petitioner and its supporters also argue that the Federal Circuit has obliterated the doctrine of equivalents. The brief case law history since *Festo* has shown that this is simply not true. Consistent with *Warner-Jenkinson* and *Festo*, the lower courts have been carefully interpreting the breadth and applicability of prosecution history estoppel to avoid barring meritorious claims from application of the doctrine of equivalents. For example, in *Turbocare*, 2001 WL 988030, the court closely examined an amended claim element in view of the teachings of the patent specification and determined that it was not narrowed and thus the doctrine of equivalents was not barred. In *ACLARA BioSciences, Inc. v. Caliper Tech. Corp.*, 125 F. Supp. 2d 391 (N.D. Cal. 2000), the court determined that a single clause in a claim contained several independent elements, only one of which was narrowed by an amendment. Accordingly, the court held that prosecution history estoppel only applied to the element narrowed by amendment, not to the

larger claim clause containing the element. *Id.* at 403. Other recent cases similarly illustrate the continuing vitality of the doctrine of equivalents.[14] *See also* Brief For The United States As Amicus Curiae at 15-16, *Festo* (No. 00-1543).

On the other hand, the *Festo* holding has been applied in other cases that demonstrate the appropriateness of invoking prosecution history estoppel to bar resort to the doctrine of equivalents for a narrowed claim element.[15]

As these cases and others proceed through the district courts and Federal Circuit, there will undoubtedly be further refinements to the doctrine of equivalents and prosecution history estoppel as anticipated by this Court in *Warner-Jenkinson*. They do not signal the doom of the doctrine of equivalents but rather its continued use and vitality as part of the patent law.

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14. *See, e.g., TM Patents, LLP v. IBM Corp.*, 136 F. Supp. 2d 209, 219 (S.D.N.Y. 2001) (prosecution history estoppel only applied to narrowed functional portion of a means-plus-function claim element); *Creo Prods. Inc. v. Presstek, Inc.*, C.A. No. 99-525-GMS, 2001 U.S. Dist. LEXIS 6226, at *34 (D. Del. May 11, 2001) (narrowing amendment limiting movement of an imaging head vis-à-vis a cylinder did not create prosecution history estoppel as to images that can result from the movement); *Graco Children's Prods., Inc. v. Regalo Int'l LLC*, No. 97-CV-6885, 2001 U.S. Dist. LEXIS 4737, at *10-13 (E.D. Pa. April 17, 2001) (prosecution history estoppel did not apply to a clarifying amendment); *SRAM Corp. v. AD-II Eng'g., Inc.*, 155 F. Supp. 2d 826, 837-38 (N.D. Ill. 2001) (prosecution history estoppel did not apply to amendment of patent specification, not the claim).

15. *See, e.g., Jackson v. Casio Phonemate, Inc.*, No. 98 C 6250, 2001 WL 395182, at *2 (N.D. Ill. April 17, 2001) (barring doctrine of equivalents where patentee narrowed claim to "more clearly distinguish[]" prior art); *Robinson v. Fakespace Labs, Inc.*, No. CIV.A.00-CV-70272-DT, 2001 WL 1057953, at *2 (E.D. Mich. Sept. 4, 2001) (barring doctrine of equivalents where claim amended to add a feature "critical to the invention" in response to prior art rejection).

C. *Festo* Does Not Provide A Roadmap For Copyists

Petitioner asserts that "the Federal Circuit has dealt the U.S. patent system a crippling blow" because "would-be competitors need only find an amended claim element in a patent, make an insubstantial change, and thereby deny the patentee protection." Brief For Petitioner at 42. Amici disagree. The definitional and public notice functions of patent claims facilitate the introduction of a myriad of new commercial products and processes that Petitioner would deny the public. It is indisputable that one of the purposes of the patent system is to encourage innovation. "Designing around" patents has long been acknowledged as one form of innovation. *See Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989) ("From their inception, the federal patent laws have embodied a careful balance between the need to promote innovation and the recognition that imitation and refinement through imitation are both necessary to invention itself and the very lifeblood of a competitive economy."); *Warner-Jenkinson*, 520 U.S. at 36; *Markman*, 517 U.S. at 390 (limits of a patent must be known to "encourage[] the inventive genius of others."). To the extent *Festo* encourages innovation by designing around, that is a recognized incentive, not a detriment.

Petitioner's argument rests on the false assumption that little thought goes into drafting and amending patent claims. Again, this is simply not true. Patent attorneys have every incentive, and the specialized expertise, to approach claim drafting and amending with utmost care. *See* ns. 4 and 11, *supra*, and accompanying text; Brief For The United States As Amicus Curiae at 24, *Festo* (No. 00-1543) ("When a patent applicant is faced with a rejection, the applicant has a particularly powerful incentive to frame its narrowing amendment as expansively as possible and to avoid surrendering any more subject matter than necessary to secure the patent. . . . [Applicants] must correspondingly draft their amendments with care."). Indeed, the experience of Amici is that a well constructed patent claim is very difficult to design around, even as to literal infringement.

This argument, and other arguments of Petitioner and its proponents, incorrectly presumes widespread incompetence on the part of patent attorneys. On the contrary, the patent bar is a highly skilled and highly trained group which does not haphazardly make amendments without consideration of their limiting effect. *See* ns. 4 and 11, *supra*, and accompanying text.

D. Patent Prosecution Will Actually Be Improved

Perhaps, as some have suggested, the Federal Circuit's decision will raise the stakes of patent prosecution and will result in tougher battles in the Patent Office over patentability. If that is the case, so be it. *See Festo*, 234 F.3d at 597 (Lourie, J., concurring) ("The fact that the applicant may have to appeal an unjustified rejection, incurring loss of time and expense, does not mean that we should refrain from adding clarity to the meaning of claims by holding patent applicants to their actions in the Patent and Trademark Office.").[16]

Holding patentees to representations made to the Patent Office provides incentive for patent applicants to assess the potential patentability of their inventions more realistically and craft the scope of initial patent claims on that basis. The Federal Circuit ruling encourages patent applicants to perform pre-filing prior art searches and file more realistic claims in their original

16. Contrary to Petitioner's assertion, Amici believe that *Festo* will not greatly impact patent prosecution practices. In Amici's experience, *Festo* has merely caused reemphasis of a number of well-worn good patent prosecution practices. Note the consistency of R. Faber, *Landis On Mechanics Of Patent Claim Drafting* § 57 (2d ed. 1974) (recommending filing a patent application with claims of varying scope); R. Faber, *Landis On Mechanics Of Patent Claim Drafting* § 60 (4th ed. 1998) (same); and R. Scheinfeld and P. Bagley, *Prosecution of Patents In Light Of The Federal Circuit "Festo" Decision*, New York Law Journal, Jan. 24, 2001, at 3 ("It would seem more important than ever to do a thorough preapplication search to identify the existing prior art so that it can be distinguished in the originally presented claims. It is a good practice to draft different sets of claims with varying claim scope and most favorably, varying claim styles and features.").

patent applications to avoid narrowing claim amendments during prosecution. Patent scope should not be treated as an interim determination that can be reevaluated *de novo* years later when the incentive for litigation arises, but should be decided in the Patent Office. *Festo* encourages precisely this end.

E. Different Treatment For An Amended Claim Versus An Original Claim Is Appropriate

Petitioner and its proponents have argued that the Federal Circuit ruling is not logical because, as a hypothetical, an allowed original claim and an amended claim having the same language would be treated differently for purposes of the doctrine of equivalents. The *Exhibit Supply* Court, considering this very issue, ruled that such different treatment is appropriate because in the case of an amended claim, the patentee had joined issue with the patent examiner during prosecution of the patent:

> Assuming that the patentee would have been entitled to equivalents embracing the accused devices had he originally claimed a "conductor means embedded in the table," *a very different issue is presented when the applicant in order to meet objections in the Patent Office, based on references to the prior art, adopted the phrase as a substitute for the broader one* "carried by the table". Had Claim 7 been allowed in its original form it would have read upon all the accused devices since in all the conductor means complementary to the coil spring are "carried by the table". By striking that phrase from the claim and substituting for it "embedded in the table" the applicant restricted his claim to those combinations in which the conductor means, though carried on the table, is also embedded in it.

315 U.S. at 136 (emphasis added). The joinder of issue is apparent to the public in the prosecution history and as to the issue joined, *i.e.* the claim element amended, the public has express notice of the surrender of equivalents.

F. The Rebuttable Presumption Of *Warner-Jenkinson* Has Not Been Eviscerated

Petitioner and its proponents argue that the Federal Circuit has eviscerated the rebuttable presumption of *Warner-Jenkinson* because, by requiring that the reasons for an amendment appear in the prosecution history record, there is no role for that rebuttable presumption when reasons are not in the record. Amici disagree.

Warner-Jenkinson established the rebuttable presumption of prosecution history estoppel for unexplained amendments (*i.e.* amendments not accompanied by remarks stating reasons for the amendments). That presumption remains undisturbed by *Festo*. Under *Festo*, a patentee can rebut the presumption of prosecution history estoppel arising from an unexplained amendment by arguing from the language of the amendment itself in the context of the prosecution history that the amendment was not narrowing or not related to statutory requirements for patentability. *Festo* 234 F.3d at 586 n. 6 ("we wish to make it clear that, in determining the reason for an amendment, a court can properly consider any *attorney argument* regarding the reason for the amendment that is *supported by the prosecution history record*.") (emphasis added); *see Warner-Jenkinson*, 517 U.S. at 34 ("On remand, the Federal Circuit can consider whether reasons for that portion of the amendment was offered or not and whether *further opportunity* to establish such reasons would be proper.") (emphasis added). Thus, there is a clear role for the rebuttable presumption of *Warner-Jenkinson* for unexplained amendments after *Festo* — namely, the presumption can be rebutted by attorney argument based on the claim language as originally composed and amended, along with the patent specification, drawings, other claims, prosecution history and the prior art in the prosecution history.[17]

17. Petitioner and one amicus suggest that a patentee should be able to rely on evidence "outside the record" of the patent prosecution history to rebut the presumption of prosecution history estoppel. (Cont'd)

G. *Festo* Is Not Contrary To Foreign Law And Does Not Violate International Treaties

Petitioner and its proponents suggest, without any substantive analysis or citation to particular foreign patent laws, that *Festo* is contrary to foreign laws and therefore violates international treaties. Petitioner's proponents similarly make the bald assertion that *Festo* is inconsistent with patent law harmonization efforts. Neither point is correct.

Principal trading partners of the United States do not have rules of law analogous to the United States doctrine of equivalents. Approaches to equivalents employed overseas vary because they are related to the particular claiming practices, statutory claiming requirements and claim construction case law of each country.[18] *Festo* could not violate international treaties because there is no single accepted international standard for the doctrine of equivalents. In any event, assuring that United States law is consistent with foreign law in accordance with international treaties should be a matter for Congress. U.S. Const. art. II.

(Cont'd)
However, allowing patentees to rely on extrinsic evidence to rebut the presumption of prosecution history estoppel would lend itself to abuse, and courts have routinely rejected that argument. *See, e.g., Pioneer Magnetics, Inc. v. Micro Linear Corp.*, 238 F.3d 1341, 1344-45 (Fed. Cir. 2001) (refusing to consider patent attorney's declaration regarding the reason for amendment made more than eight years following the amendment), *petition for cert. filed*, 70 U.S.L.W. 3036 (U.S. May 23, 2001) (No. 00-1765); *Pickholtz v. Rainbow Techs., Inc.*, 125 F. Supp. 2d 1156, 1162 (N.D. Cal. 2000) (excluding attorney declaration made 15 years after the amendment).

18. *See* R. Weston, Jr., *A Comparative Analysis Of The Doctrine Of Equivalents: Can European Approaches Solve An American Dilemma?*, 39 J.L. & Tech. 35 (1998) (noting different approaches to claim construction and equivalents in the U.S., U.K. and Germany); A. Soobert, *Analyzing Infringement By Equivalents: A Proposal To Focus The Scope Of International Patent Protection*, 22 Rutgers Computer & Tech. L.J. 189 (1996) (distinguishing approaches to claim construction and equivalents in the U.S., U.K., Germany and Japan).

CONCLUSION

The judgment should be affirmed because the Federal Circuit correctly held that an estoppel can and should be created in *all* contexts in which an amendment narrows the scope of a claim element for any reason related to a statutory requirement for a patent and that such an amendment serves as a disclaimer to completely bar application of the doctrine of equivalents as to the amended claim element.

Respectfully submitted,

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